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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,028	07/10/2000	Eric Michael Lunsford	PALM-3184.US.P	9582
7590 04/20/2004 Wagner Murabito & Hao LLP Two North Market Street Third Floor San Jose, CA 95113			EXAMINER MENGISTU, AMARE	
			ART UNIT	PAPER NUMBER
			2673	12
DATE MAILED: 04/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/613,028

**Applicant(s)**

LUNSFORD ET AL.

**Examiner**

Amare Mengistu

**Art Unit**

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11-16, 21-28, 33-41 and 46-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 11-16, 21-28, 33-41, 46-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 7-10,17-20,29-32,42-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 6.

***Claim Rejections - 35 USC § 112***

2. Claims 2,12,24 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of the claims 2,12,24 and 37 "***said one or more first gesture correspond to a plurality of handwriting stroke***" is not clear. How can it be possible for a removable template to correspond to a plurality to handwriting strokes? How does a template correspond to a handwriting strokes? Does that mean that the templates associated to characters, which corresponds to handwriting?

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-5,3,11-15,23-27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Deeran et al (5,594,471)**[see, figs.1, 4,5].

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 23-27,36-40,46 are rejected under 35 U.S.C. 102(b) as being anticipated by **Deeran et al (5,594,471)**.

7. As to claims 23 and 36, **Deeran et al** discloses an electronic system comprising: an electronic display device (fig.2 (26)) coupled to a bus (fig.2 (24)); a memory device (fig.2 (27)) coupled to said bus (fig.2 (24)); a data input device (fig.2 (10)) coupled to said bus (fig.2 (24)); a data input surface (fig.1 (14,16)); a user removable template (fig 1(15,17), col.2, lines 53-63), a first data input area (fig.1 (17); fig.4 (Zone 2), also see, col.3, lines 36-45, col.4, lines 61- col.5, lines 5); a second data input area (fig.1(15); fig.4 (Zone 1,3) note: col.3, lines 36-45, col.5, lines 6-13). It is inherent for **Deeran et al** device to have a processor and the processor to be coupled to a bus.

8. As to claims 24-27,37-40, **Deeran et al** discloses said one or more first gesture correspond to a plurality of handwriting strokes (col.4, lines 61-col.5, lines 5); a second data input area is a keyboard template (col.4, lines 31-34); a second data input area is an application shortcut (col.5, lines 6-13); wherein said plurality of application

correspond to a predetermined number of previously invoked applications (col.4, lines 61- col.5, lines 5)

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 22,35,48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Deeran et al (5,594,471)** in view of **Matsui et al (5,493,365)**.

As to claims 22 and 48, **Deeran et al** discloses removable templates, but has failed to teach configuring the removable of the data input. However, **Matsui et al** clearly teaches that it is well known for the user removable data input device includes a mechanism for automatically configuring to recognize said user removable data input device (col.4, lines 23-35).

In regard to claims 35 and 49, **Matsui** also discloses an electronic system having one or more communication ports (see, fig.1 (16); fig.2 (36-38,43); fig.3, the key unit communicating with CPU; fig.7 (75)).

11. Claims 6,16,28,41 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Deeran et al (5,594,471)** in view of **Ganthier et al (5,865,546)** and **Sylvan et al (5,572,573)**.

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12. As to claims 6,16,28,41 **Deeran et al** discloses a removable input device but did not explicitly disclose discloses the input device including a game control keys.

However; **Ganthier et al** discloses a keyboard module and suggest that a user can replace each input device module with a different input device (see, abstract; col.2, lines 56-64).

Thus, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to replace one of the input device with a game control device as taught by **Ganthier** into the device of **Deeran et al** because this will allow the user with more flexibility to control and minimizing the amount of input device on the keyboard.

13. Claims 21,34 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Deeran et al** (5,594,471) in view of **Sylvan et al** (5,572,573).

14. As to claims 21,34 and 47 **Deeran et al** discloses a computer touch screen input device, but **Deeran et al** has failed to disclose that the computer system is a PDA. The patent of **Sylvan et al** is cited to teach that it is well known for PDA to have both touch pad or a keyboard (see, figs.1, 2, 8 and 9).

Therefore it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to use a PDA with a keyboard or touch screen as taught by **Sylvan et al** into the device of **Deeran et al**, since this will provide user with more compact and efficient electronic input system.

*Response to Arguments*

15. Applicant's arguments with respect to claims 1-6,11-16,21-28,33-42,47-49 have been considered but are moot in view of the new ground(s) of rejection.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare Mengistu whose telephone number is (703) 305-4880. The examiner can normally be reached on M-F, T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

  
Amare Mengistu  
Primary Examiner  
Art Unit 2673

A.M  
April 17, 2004